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Paper No. 12

LIU & LIU
444 S. FLOWER STREET
SUITE 1750
LOS ANGELES, CA 90071

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OCT 26 2005

OFFICE OF PETITIONS

In re Application of :
Rhee et al :
Application No. 09/763,589 :
Filed: February 23, 2001 :
For: METHOD AND DEVICE FOR GENERATING : ON PETITION
VOICE/TEXT/IMAGE COMMERCIAL INFORMATION :
RINGBACK TONE DURING COMMUNICATION WAIT :

This correspondence is in response to the petition to revive an application abandoned unavoidably under 37 CFR 1.137(a), filed April 13, 2004. The petition is properly treated as a petition under 37 CFR 1.181, to withdraw the holding of abandonment. The delay in treating this petition is regretted.

A Decision on Petition is held in abeyance pending resolution of the ownership question.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed November 18, 2003. The Notice set a three (3) month period for reply. No reply having been received, the application became abandoned on February 19, 2004. A Notice of Abandonment was mailed September 22, 2004.

The instant petition

Applicant files the instant petition wherein Applicant asserts that that a Revocation of Power of Attorney and Power of Attorney were filed in this Office on June 30, 2003. In support of this assertion, Applicant files a copy of his return-receipt postcard evidencing receipt of Change of a Revocation of Power of Attorney and Power of Attorney; Statement Under 37 CFR 3.73(b), and Copies of Assignment.

Review of the File

A review of the application file reveals that the Applicant was filed on February 23, 2001, by the firm of Lee & Hong, 221 N. Figueroa Street, Los Angeles, CA 90012-2601. The Declaration and Power of Attorney filed with the application directed correspondence to Lee & Hong P.C., 221 N. Figueroa Street, 11th Floor, Los Angeles, CA 90012-2601. A Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 was mailed to Lee & Hong at 221 N. Figueroa Street, Los Angeles, CA 90012-2601 on November 17, 1999.

On July 25, 2002 (Certificate of Mailing dated July 18, 2002), the firm of Lee & Hong filed a Request for a Corrected Filing Receipt, requesting correction of the title from "rinback" to "ringback".

Thereafter, an assignment was recorded on January 7, 2003, wherein inventors Hyoungh Chan Rhee and Jong Su Hong assigned their rights in the application to Ringfree Co., LTD., and identifying Lee & Hong P.C., 221 N. Figueroa Street, 11th Floor, Los Angeles, CA 90012, as the correspondence address.

A second assignment was recorded on February 10, 2003, wherein inventor Hyoungh Chan Rhee, in his capacity as President/Representative Director of Ringfree Co., LTD., assigned the rights of the invention to Ringfree International Corporation ("Ringfree").

Ringfree then revoked the power of attorney and changed the correspondence address

On June 24, 2003, the firm of Liu & Liu, filed a Revocation of Power of Attorney and Power of Attorney, executed by Richard Bertsch in his capacity as President/CEO of Ringfree International Corporation. The petition was accompanied by a Statement Under 37 CFR 3.73(b), evidencing Mr. Bertsch's authority to act on behalf of the assignee. The petition was also accompanied by a copy of both assignments.

This Office failed to enter the change

On November 13, 2003, an Information Disclosure Statement ("IDS") was filed by the original firm of Lee, Hong, Dogerman,

Kang & Schmadeka, 801 N. Figueroa Street, 14th Floor, Los Angeles, CA 90017-5554¹.

On November 18, 2003 this Office mailed the final Office action to Lee & Hong at 221 N. Figueroa Street, 11th Floor, Los Angeles, CA 90012.

On May 17, 2004 (Certificate of Mailing dated May 12, 2004), a Petition and Fee to Void Assignment was filed by Lee, Hong, Dogerman, Kang & Schmadeka, 801 N. Figueroa Street, 14th Floor, Los Angeles, CA 90017².

On May 18, 2004, this Office mailed a Notice Regarding Change of Power of Attorney to Lee & Hong, and a Notice of Acceptance of Power of Attorney to Liu & Liu.

On September 10, 2004, Liu & Liu filed correspondence requesting withdrawal of the abandonment of the application based upon the Revocation of Power of Attorney and Power of Attorney filed June 24, 2003.

On September 22, 2004, a Notice of Abandonment was mailed to Liu & Liu.

On April 13, 2005, Liu & Liu files the instant petition; however, the correspondence address listed on the petition is 444 S. Flower Street, Suite 1750, Los Angeles, CA 90071, which is different from the correspondence address of record.

Conclusion

In view of the Petition and Fee to Void Assignment filed May 17, 2004, "the ownership established as controlling is contested on the record". The Manual of Patent Examining Procedure ("MPEP") provides that where

the ownership established as controlling is contested on the record by another party who has submitted a conflicting 37 CFR 3.73(b) statement, then the application or other proceeding shall be forwarded by the

¹Office records do not indicate that a Revocation of Power of Attorney/Power of Attorney or a Change of Correspondence Address was filed by Lee & Hong or Lee, Hong, Dogerman, Kang & Schmadeka.

²A Decision of this petition is also being held in abeyance until the ownership issue has been resolved.

Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolution of the ownership question.

Accordingly, the application file is being forwarded to the Office of Patent Legal Administration for resolution of the ownership question.

Further correspondence with respect to this Decision should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


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Office of the Deputy Commissioner
for Patent Examination Policy

Cc: Lee, Hong, Dogerman,
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